

Appl. No. 10/003,013
Amdt. Dated 11/25/2005
Reply to the Office Action of 08/25/2005

REMARKS

Applicants respectfully request entry of this reply under the provisions of 37 C.F.R. § 1.116(a) in that the remarks below assert that the application and claims are in condition for allowance, or, at least, present the application in better form for appeal. It is submitted that the application is in condition for allowance. Claims 1-31 remain pending in this application.

Claim Rejections - under 35 USC § 102

The Examiner rejected Claims 1 and 3-31 under 35 U.S.C. 102(b) as being anticipated by Mandel (U.S. Patent No. 5,435,544). The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Mandel.¹

With regards to claims 1 and 22, the Applicants assert that the Examiner is impermissibly dissecting the limitations of these claims and that the Mandel reference does not teach or suggest the limitations of these claims as they are written. For example, claim 1 recites:

A method of presenting a printer operator interface, the method comprising the steps of
generating a printer operator display dataset in a processor within a printer, wherein the operator display dataset defines a printer operator interface display and wherein the display dataset conforms to a network protocol;

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

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interpreting, through use of the network protocol, the printer operator display dataset within the printer; and
displaying the operator interface display on a display on the printer.

The Applicants point out that the “operator interface display” set forth in the above claim limitations is defined by the “printer operator display dataset.” The Applicants assert that, as used in these claims and in the context of the Applicants’ specification, the term “operator interface display” refers to the data that is presented to an operator. Furthermore, the last limitation of claim 1 recites “displaying the operator interface display on a display on the printer.” The Applicants assert that it is clear from the claim language itself that since “the operator display dataset defines a printer operator interface display,” and that this “display is displayed “on a display on the printer,” the “display” as used in claims 1 and 22 is the information presented to the operator.

Furthermore, it is clear from the explicit limitations of claims 1 and 22 that the information in the “display dataset” is interpreted within the printer and that the same information defined by the “display dataset” is displayed on the printer.

In addition to the above described claim language, these terms are also used in the same manner within the Applicants’ specification. For example:

Relevant to the embodiment of the present invention is the option to store, within the non-volatile memory, data which defines operator displays on a video display terminal. (Specification, page 5, lines 1-3, emphasis added)

Web Server 204 generates the data defining displays that are presented to an operator. In the preferred embodiment, the Web Server 204 generates a display data set, which defines a display to be presented to the operator, based upon the HTTP standard. Alternative embodiments may incorporate other network standard protocols or other standard protocols used on computer networks such as Java or XML. (Specification, page 8, lines 9-13, emphasis added)

The Examiner cites separate portions of Mandel for a teaching of a “display

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dataset” and “a printer operator interface display.” As for a teaching of the “interpreting” limitation of these claims, the Examiner cites a portion of the Mandel reference that overlaps with the citation of a teaching of the “display dataset.” Office Action dated August 25, 2005, page 3, paragraphs 1 and 2. The failure of Mandel to sufficiently teach each of these items, particularly within the context of the currently pending claims, is discussed separately below.

The portion of the Mandel references cited as teaching a “display dataset” is characterized by the Examiner as teaching “messages.” *Id.* Mandel does teach “network messages” that are sent to a job senders’ terminal “so that the users screen displays a status message like ‘your job is in bin #3’; or ‘the printer is out of paper’; or the like.” Mandel, Column 1, lines 41-46. The Examiner cites this portion of Mandel as a teaching of both the “display dataset” and the “interpreting” limitation of claims 1 and 22. The Applicants point out that the Examiner’s remarks in the pending Office Action do not recite the entire “interpreting” limitation, which, when considered in its entirety, recites: “interpreting, through use of the network protocol, the printer operator display dataset within the printer.”

The Applicants assert that there is no teaching or suggestion in Mandel that these “messages” are ever interpreted in any way “within the printer.” as is recited for claims 1 and 22. More specifically, Mandel never teaches or suggests “interpreting, through the use of the network protocol, the printer operator display dataset within the printer.” It is clear from the context of the Mandel reference, that “network messages” are only sent to remote devices, such as a user’s terminal, and are never intended to be processed by “interpreting, through the use of the network protocol, ... within the printer.”

Furthermore, the Applicants assert that the Mandel reference never teaches or suggests, either explicitly or inherently, that the data contained within the “network messages” of Mandel is ever displayed “on a display on the printer.” The Applicants assert that in order to properly anticipate claims 1, 12 and 22, the Mandel reference is

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required to display the "operator interface display" that is defined within the printer operator display dataset which is generated "in a processor within a printer" and interpreted "within the printer."

The portion of the Mandel reference cited as a teaching of a "printer operator interface display" appears to be a portion that describes user interface devices that are part of a printer/mailbox device and a reference to a voice-mail or network message sent back to a sender's terminal. Mandel, column 29, columns 1-30. The user interface devices described by this cited portion of Mandel include a "conventional beeper or other audio signaling device" and "a central LCD, CRT or other shared common display." *Id.* Although this portion of Mandel repeats the network message discussed in the above remarks and further mentions voice-mail, there is no teaching or suggestion that any "operator interface display" that may be defined in these "messages" is ever interpreted "within the printer" as is required by the claim language.

The Applicants reassert the above remarks with regards to the similar limitations of claims 11 and 12.

With regards to claims 3 and 14, the Examiner appears to be only referring to the teaching of sending pre-stored "voice-mail" voice messages that are triggered by a printer controller. Office Action dated August 24, 2005, page 3, last paragraph, citing Mandel, column 29, lines 20-35 and 10-35. The Applicants also point out that claim 24 was rejected in conjunction with claims 10, 21 and 31. Office Action dated August 24, 2005, page 5, paragraph number 9. The Applicants point out that claim 24 corresponds to the subject matter of claims 3 and 14. The Applicants therefore assert that the following remarks address the patentability of claim 24 as well. The Applicants point out that the voice messages taught by Mandel are pre-stored electronic messages that are stored within "presently available voice-mail systems, such as Xerox 'V-Max'." The Applicants point out that claims 3, 14 and 24 recite that the "sound file" or other recited content as being within "the operator display dataset." Furthermore, the Applicants point out that in the

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context of these claims “the operator display dataset” is described in claims from which these claims depend as being generated “in a processor within a printer.” See, claims 1, 12 and 22. The Applicants assert that the “presently available voice-mail systems” taught by Mandel are not “a processor within a printer” as set forth by claims 3, 14 and 30. Further, these voice mail voice messages are not taught or suggested by Mandel as being processed by “interpreting, through use of the network protocol, ... within the printer.”

With regards to claims 6, 17 and 27, the Applicants refer to claim 6 as an example and assert that similar remarks apply to claims 17 and 27. The Applicants point out that claim 6 specifies that the “generating is repetitively performed at a time period.” The Applicants point out that the “generating” refers to “generating a printer operator display dataset” as defined by claim 1. This dataset, in the context of these claims, defines a printer operator interface display and is interpreted, through use of the network protocol, ... within the printer. The Examiner apparently cites two portions of the Mandel reference, one portion that describes periodically interrogating bin-empty sensors and a separate, unrelated portion that describes message generation. Office Action dated August 24, 2005, page 4, paragraph number 5, citing Mandel, column 30, lines 55-65, and column 29, lines 35-47. At most, these teachings may imply that a “message” may be triggered by a sensor being read and indicating a “bin empty.” The Applicants assert that there is no explicit or inherent direct teaching of this scenario and further assert that the repetitive generation of a message is not inherent in the teaching of Mandel. The Applicants assert that this is not an anticipatory teaching of the limitation of claim 6, where the “generating is repetitively performed at a time period. The Applicants further point out that Mandel only describes this “period” as being “preferably done each time the printer and/or print server is sent (and/or is preparing to print) a print job.” Mandel, column 30, lines 61-63. The Applicants assert that sending print jobs does not typically occur “at a time period” as is recited for claims 6, 17 and 27. As is described below with regards to claims 7, 18 and 28, the delay depicted in FIG. 20 of Mandel is not part of “generating a printer operator display dataset” and is not even part of the interrogating of sensors as discussed in the cited portion of Mandel.

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With respect to claims 7, 18 and 28, the Applicants fail to see where the Mandel reference teaches that “the time period is adjusted.” The cited portions of Mandel teach interrogating sensors that is “preferable done each time the printer and/or print server is sent (and/or is preparing to print) a print job.” Mandel, column 30, lines 61-63. The Applicants further assert that the “time delay” of FIG. 20 of the Mandel reference is only associated with checking user input, checking if the user has “a job in one of the bins,” checking if the bins are currently idle or determining “the first bin to unload. See, preceding flow of FIG. 19 and related flow of FIG. 21 of Mandel. The Applicants assert that the time delay of FIG. 20 is clearly unrelated to any “generating” as set forth for the presently claimed invention, which is required by claims 7, 18 and 28, and cannot be cited by as an anticipatory teaching of these claims.

For at least the above reasons, the Applicants assert that independent claims 1, 11, 12 and 22 distinguish over the Mandel reference and that claims 3, 14, and 24; 6, 17 and 27; and claims 7, 18 and 28; further distinguish over the Mandel reference. Furthermore, dependent claims 3-10, 13-21, and 23-31 are believed to be patentable as well because they depend on claims 1, 12, and 22, respectively, and contain all of the limitations of those claims. Accordingly, the present invention distinguishes over Mandel for at least this reason. Therefore the Applicants respectfully submit that the Examiner’s rejection under 35 U.S.C. § 102(b) has been overcome.

Claim Rejections - under 35 USC § 103

The Examiner rejected Claim 2 under 35 U.S.C. 103(a) as being unpatentable Mandel (U.S. Patent No. 5,435,544) in view of Hammond et al. (U.S. Patent No. 6,820,067) (hereinafter “Hammond”).²

² Applicant makes no statements as to whether such a combination is even proper.

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Applicants wish to point out that the Hammond reference merely discloses accessing hypertext documents with client and server software using Hypertext Transport Protocol (HTTP), which is well-known in the art. Hammond, column. 2, lines 52-56. However, Hammond does not teach creating a "display dataset" that "defines a printer operator interface display." As discussed above, the Mandel reference does not include a proper teaching of such a "display dataset," particularly when considering the claims "as a whole." The Applicants assert that the Hammond reference also does not teach or suggest the claimed limitations discussed above as lacking in the Mandel reference.

The Examiner cites 35 U.S.C. § 103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter as a whole and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention as a whole. Continuing further, when there is no suggestion or teaching in the prior art for that disclosed in the application, the suggestion can not come from the Applicants' own specification, as the Federal Circuit has repeatedly warned against using the Applicants' disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

It is accordingly believed that Mandel, whether taken alone or in arguable combination with Hammond et al., neither teaches nor suggests the features of Claim 1 or the limitation of claims 2, 13 or 23. Since dependent claims contain all the limitations of the independent claims, claims 2, 13 and 23 also distinguishes over Mandel and Hammond et al., individually, and also distinguishes over any combination of the two cited references. Therefore, the Applicants assert that the rejection of claim 2, and claims 13 and 23, under 35 U.S.C. §103(a) should be withdrawn.

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Conclusion

The foregoing is submitted as full and complete response to the Official Action mailed August 25, 2005, and it is submitted that Claims 1-31 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of Claims 1-31 is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicants acknowledge the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and the attorneys.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 50-1556.

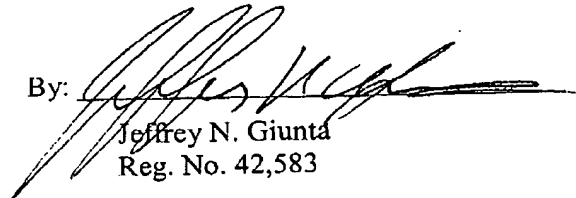
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In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date: November 25, 2005

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